

Amendments to the Drawings:

The attached sheet of drawings includes changes to Figures 9B and 9C. This sheet, which includes Figures 9A, 9B, and 9C, replaces the original sheet including 9A, 9B, and 9C. In Figures 9B and 9C, element numeral 912 is added.

Attachments: Replacement Sheet
Annotated Sheet Showing Changes

REMARKS/ARGUMENTS

Introduction:

Claims 1, 42, 89, 91, 94, 95, and 99 are amended, and claims 100-104 are added. Claims 26, 33, 35, 36, 41, 42, 48, 73-85, 87, 89-92, and 94-104 are now pending in the application. (Claims 1-25, 27-32, 34, 37-40, 43-47, 49-72, 86, 88, and 93 were previously canceled.) In addition, the drawings are amended. Applicants respectfully request reexamination and reconsideration of the application.

Objections To Claims And Drawings:

Claims 89 and 91 were objected to because their "dependencies are incorrect." Applicants have amended claims 89 and 91 to correct the dependencies (not for reasons of patentability.) Applicants believe that the amendments to claims 89 and 91 overcome the objection.

The drawings were objected to, and the PTO requested that an element number 912 be added to Figures 9B and 9C. Applicants submit herewith changes to Figures 9B and 9C, which Applicants believe overcome the objection to the drawings.

Rejections Under 35 USC § 112, First Paragraph:

Claims 26-33 and 36-99 were rejected under 35 USC § 112, first paragraph as allegedly containing subject matter not supported by the specification and drawings. Applicants respectfully traverse this rejection.

The MPEP sets forth the test for determining whether a specification meets the written description requirement of the first paragraph of 35 USC § 112 as follows:

The test for sufficiency of support . . . is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." (MPEP § 2163.02.)

In one non-limiting example, Figures 8A-8E of the specification illustrate a probe that comprises a body 826 and a tip 830. The specification states that the body 826 can comprise, among other materials, nickel (specification pg. 40, lines 9 and 10) and the tip 830 can comprise, among other materials, palladium cobalt (specification pg. 41, lines 8-10). Applicants respectfully assert that these non-limiting examples are more than sufficient to meet the written description requirement

for the pending claims. Nevertheless, Applicants have moved the recitation that "said body comprises a spring material that does not comprise a substantial amount of the palladium cobalt alloy" from independent claims 26, 42, 94, 95, and 99 to new dependent claims 100-104 because Applicants believe that such recitations are not necessary to distinguish the independent claims over the prior art of record. Thus, the rejection under 35 USC § 112, first paragraph is moot, at least with respect to the independent claims and all of the dependent claims except new claims 100-104. As discussed above, however, Applicants respectfully assert that the specification fully meets the written description requirement with respect to claims 100-104.

Rejections Under 35 USC § 103(a):

Claims 26, 33, 36, 41, 42, 48, 73-85, 87, 89-92, and 94-99 were rejected under 35 USC § 103(a) as obvious in view of US Patent No. 5,810,609 to Faraci et al. ("Faraci") in combination with one or more of US Patent No. 5,632,631 to Fjelstad ("Fjelstad"), US Patent No. 5,180,482 to Abys et al. ("Abys"), U.S. Patent No. 5,476,818 to Yanof ("Yanof"), or U.S. Patent No. 5,177,438 to Littlebury ("Littlebury"). In addition, claims 26, 33, 36, 41, 42, 48, 73-85, 87, 89-92, and 94-99 were rejected under 35 USC § 103(a) as obvious in view of U.S. Patent No. 5,811,982 to Beaman ("Beaman") in combination with one or more of Fjelstad, Abys, Yanof, or Littlebury. Applicants respectfully traverse these rejections.

In the Office Action, the PTO acknowledges that none of Faraci, Beaman, Fjelstad, Yanof, or Littlebury discloses use of palladium cobalt. It follows that no combination of those references can fully meet the recitations of the pending claims, each of which recites or depends from a claim that recites use of palladium cobalt. For at least this reason, the rejection of each of the claims in view of any combination of Faraci, Beaman, Fjelstad, Yanof, or Littlebury should be withdrawn.

To make up for the lack of teaching in Faraci, Beaman, Fjelstad, Yanof, and Littlebury of the use of palladium cobalt, the PTO cites Abys. As generally discussed in the Amendment filed September 1, 2006, however, it would not have been obvious to combine Abys with Faraci or Beaman as proposed in the Office Action. Abys does not teach or suggest using palladium cobalt in contacts designed for microelectronic circuits like the contacts disclosed in Faraci or Beaman. Abys' teachings are limited to relatively large electrical connectors, like relay contacts and switches or the macro sized contact shown in Figure 1 of Abys. (Abys col. 1, lines 19-21.)

In fact, the palladium cobalt disclosed in Abys must be shaped using stamping operations. (Abys col. 2, lines 15-18.) Without question, stamping operations cannot be used in making Faraci's microcontacts 190, 200 or Beaman's test probe 20, which are designed for use with a microelectronic device such as Faraci's device 265 or Beaman's integrated circuit device 30 and must therefore be made using delicate lithographic techniques like those used to form integrated circuits on semiconductor dies or delicate wiring bonding techniques like those used with integrated circuits. (See Faraci Figures 6A-6E and Beaman Figures 3-6.) Abys' does not explain how or even hint that its stamped palladium cobalt could or should be used with microelectronic contacts (like Faraci's or Beaman's) fabricated using delicate operations associated with semiconductor devices. Indeed, it would not be possible to apply Abys' teachings regarding shaping palladium cobalt by stamping to use with the micro sized, lithographically produced structures and circuits of Faraci or Beaman. Therefore, it would not have been obvious to combine Abys with Faraci or Beaman as proposed in the Office Action, and the rejection of each of the claims should accordingly be withdrawn.

In the PTO's response to similar arguments made by Applicants in previous Amendments, the PTO seems to imply that the use of palladium cobalt can be presumed to be obvious unless specific examples of advantages of palladium cobalt over other materials are disclosed in the specification. (Office Action, ¶ 3.) No court case, statute, PTO rule, or MPEP section, however, supports such a position. To the contrary, the MPEP expressly describes the requirements to establish a *prima facie* case of obviousness as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (MPEP § 2143.)

Applicants arguments regarding the impropriety of combining Abys with Faraci or Beaman cannot therefore be dismissed on the grounds that the specification allegedly does not disclose examples of advantages of palladium cobalt over other materials.

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Amdt. dated February 6, 2007
Reply to Office Action of November 6, 2006

Conclusion:

In view of the foregoing, Applicants submit that all of the claims are allowable and the application is in condition for allowance. If the Examiner believes that a discussion with Applicants' attorney would be helpful, the Examiner is invited to contact the undersigned at (801) 323-5934.

Respectfully submitted,

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